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HUNTSINGER, PETER K				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/674,493

**Applicant(s)**

IKENO, HIDEO

**Examiner**

Peter K. Huntsinger

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2,5-10 and 16-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date 6/04

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species:

Species I, which relates to setting a plurality of print languages to a particular resource, presented in Figs. 4, 5 and 7.

Species II, which relates to setting an individual print language to one of a plurality of names of resources, presented in Figs. 10-12.

The invention can only perform one of these settings, not both, and therefore the species are mutually exclusive.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 6-10, 16-18, 24 and 25 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

2. During a telephone conversation with Frank Cire on 3/14/08 a provisional election was made without traverse to prosecute the invention of Species II, claims 5, 19-23, 26 and 27. Affirmation of this election must be made by applicant in replying to this Office action. Claim 3, 4, and 11-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on 6/23/04 was filed after the mailing date of the application on 10/1/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said list display step" in lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 includes the limitation: "wherein display-name information set by said second setting means indicates that the resource is not to be displayed" (i.e. 1111 of Fig. 11). Claim 22 is dependent on claim 20 which includes the limitation: "second setting means for setting, with respect to each resource within said image processing apparatus, display-name information, which indicates names used in display, as information indicating features of these resources, the display-name information being set for every print language received by said image processing apparatus." It is unclear how the second setting means sets the names used in display (claim 20) and also sets the resource not to be displayed (claim 22).

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claim 8, while defining a computer program product, does not define a "computer-readable medium" and is thus non-statutory for that reason. A computer program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Scheidig '565.

Referring to **claim 18**, Scheidig '565 discloses an image forming apparatus that is capable of processing print data, which is based upon print languages of a plurality of types, using a specified resource (Fig. 2a, col. 5, lines 36-42, language-dependent parameters 11), wherein actual data of the resource and attributes corresponding to each of the processable plurality of types of print languages are stored in associated form (Fig. 2b col. 5, lines 22-35, emulation mode-dependent data deposited on the hard disk).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 6-9, 16, 17, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheidig '565 in view of Nguyen '941.

Referring to **claim 1**, Scheidig '565 discloses a resource management method for managing a resource retained by an image forming apparatus, which is based upon



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print languages of a plurality of types, using a specified resource (Fig. 2a, col. 5, lines 36-42, language-dependent parameters 11), comprising:

a setting step of setting attributes, with regard to the resource, corresponding to each of the plurality of types of print languages processable by the image forming apparatus (Fig. 2b. col. 5, lines 22-35, user inputs setting data for different printer languages); and

a storage step of storing the attributes, which have been set at said setting step, in the image forming apparatus in association with actual data of the resource retained by the image forming apparatus (Fig. 2b col. 5, lines 22-35, emulation mode-dependent data deposited on the hard disk).

Scheidig '565 discloses the resource enables image processing of print data but does not disclose expressly that the resource is capable of processing print data.

Nguyen '941 discloses resources retained by an image forming apparatus that are capable of processing print data (col. 8, lines 4-25, modules that modify the output data stream sent to the printer).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize multiple individual modules to process print data. The motivation for doing so would have been to eliminate requiring one large monolithic print driver in the printer. Therefore, it would have been obvious to combine Nguyen '941 with Scheidig '565 to obtain the invention as specified in claim 1.

Referring to **claim 6**, Nguyen '941 discloses wherein the resource is a font resource used in printing, and/or a form resource for forming an image by being

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superimposed on print data at the time of printing, and/or a color-profile resource that expresses color space of an input/output device, and/or a look-up-table resource, which is a conversion table for color correction in color processing, and/or a dither-pattern resource, which is pattern data for deciding expression of color in color processing (col. 8, lines 64-65, font and raster modules).

Referring to **claim 7**, Scheidig '565 discloses a resource management method for managing a resource retained by a device that has a plurality of mutually different processors using a resource specified by the input data (Fig. 2a, col. 5, lines 36-42, language-dependent parameters 11), comprising:

a setting step of setting attributes, with regard to the resource, corresponding to each of the plurality of mutually different processors implemented in the device (Fig. 2b. col. 5, lines 22-35, user inputs setting data for different printer languages); and

a storage step of storing the attributes, which have been set at said setting step, in the image forming apparatus in association with actual data of the resource retained by the image forming apparatus (Fig. 2b col. 5, lines 22-35, emulation mode-dependent data deposited on the hard disk).

Scheidig '565 discloses the resource enables image processing of print data but does not disclose expressly that the resource is capable of processing input data.

Nguyen '941 discloses resources retained by an image forming apparatus that are capable of processing input data (col. 8, lines 4-25, modules that modify the output data stream sent to the printer).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize multiple individual modules to process print data. The motivation for doing so would have been to eliminate requiring one large monolithic print driver in the printer. Therefore, it would have been obvious to combine Nguyen '941 with Scheidig '565 to obtain the invention as specified in claim 1.

Referring to **claim 8**, see the rejection of claim 1 above.

Referring to **claim 9**, see the rejection of claim 1 above.

Referring to **claim 16**, see the rejection of claim 6 above.

Referring to **claim 17**, see the rejection of claim 7 above.

Referring to **claim 24**, see the rejection of claim 1 above.

Referring to **claim 25**, see the rejection of claim 7 above.

14. Claims 2, 5, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheidig '565 and Nguyen '941 as applied to claims 1 and 9 above, and further in view of Haines '030.

Referring to **claim 2**, Scheidig '565 discloses wherein said storage step stores attributes regarding the resource in association with the actual data of the resource (Fig. 2b col. 5, lines 22-35, emulation mode-dependent data deposited on the hard disk).

Scheidig '565 does not disclose expressly downloading a resource to the image forming apparatus.

Haines '030 discloses a download step of downloading actual data of a resource to the image forming apparatus (block 424, of Fig. 5, page 5, paragraph 54, server sends a set of media parameters to imaging device).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to download a resource to the printer. The motivation for doing so would have been to provide a more optimal resource for the printer. Therefore, it would have been obvious to combine Haines '030 with Scheidig '565 and Nguyen '941 to obtain the invention as specified in claim 2.

Referring to **claim 5**, Scheidig '565 discloses wherein a name of a resource corresponding to each print language is included as an attribute corresponding to each of the plurality of types of print languages, and said list display step displays a resource name, which has been specified with regard to each print language, in such a manner that this fact can be recognized (Fig, 2a, col. 5, lines 36-42, language-dependent parameters 11).

Referring to **claim 10**, see the rejection of claim 2 above.

15. Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen '941 in view of Scheidig '565.

Referring to **claim 19**, Nguyen '941 discloses a data processing apparatus, which communicates with an image processing apparatus that processes image data while utilizing resources retained in a memory, for executing prescribed image

processing utilizing resources managed by the memory (col. 8, lines 4-25, modules that modify the output data stream sent to the printer), comprising:

retention means for retaining resources, which are utilized in image processing, together with information indicating features of the resources on a per-resource basis (Fig. 8, col. 14, lines 21-28, displays modules node in user interface); and

first setting means for setting, with respect to each resource stored in the memory within the image processing apparatus, two or more items of display-name information as information indicating the features of these resources (Fig. 8, col. 4, lines 32-45, user interface displays all printer features/modules).

Nguyen '941 does not disclose expressly setting display-name information for every print language.

Scheidig '565 discloses second setting means for setting, with respect to each resource stored in the memory within the image processing apparatus, display-name information, which indicates names used in display, as information indicating features of these resources, the display-name information being set for every print language received by the image processing apparatus (Fig. 2b. col. 5, lines 22-35, user inputs setting data for different printer languages).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to set a resource for every printer language. The motivation for doing so would have been to optimize print process according to the requirements of a particular print language. Therefore, it would have been obvious to combine Scheidig '565 with Nguyen '941 to obtain the invention as specified in claim 19.

Referring to **claim 26**, see the rejection of claim 19 above.

16. Claims 20, 21, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen '941 in view of Haines '030 and Scheidig '565.

Referring to **claim 20**, Nguyen '941 discloses a data processing apparatus for use with an image processing apparatus in which resources utilized in image processing within the image processing apparatus (col. 8, lines 4-25, modules that modify the output data stream sent to the printer) are retained together with information indicating features of the resources on a per-resource basis (Fig. 8, col. 4, lines 32-45, user interface displays all printer features/modules), print data or input data based upon print languages of a plurality of types is received, and image data is processed while utilizing resources that are retained within the image processing apparatus from an initial state, or that are downloaded, in accordance with a resource utilization command sent together with the print data or input data, said data processing apparatus comprising:

first setting means for setting, with respect to each resource within said image processing apparatus, two or more items of display-name information as information indicating the features of these resources (Fig. 8, col. 4, lines 32-45, user interface displays all printer features/modules).

Nguyen '941 does not disclose expressly downloading a resource to the image forming apparatus.

Haines '030 discloses a download step of downloading actual data of a resource to the image forming apparatus (block 424, of Fig. 5, page 5, paragraph 54, server sends a set of media parameters to imaging device).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to download a resource to the printer. The motivation for doing so would have been to provide a more optimal resource for the printer.

Nguyen '941 does not disclose expressly setting display-name information for every print language.

Scheidig '565 discloses second setting means for setting, with respect to each resource stored in the memory within the image processing apparatus, display-name information, which indicates names used in display, as information indicating features of these resources, the display-name information being set for every print language received by the image processing apparatus (Fig. 2b. col. 5, lines 22-35, user inputs setting data for different printer languages).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to set a resource for every printer language. The motivation for doing so would have been to optimize print process according to the requirements of a particular print language. Therefore, it would have been obvious to combine Haines '030 and Scheidig '565 with Nguyen '941 to obtain the invention as specified in claim 20.

Referring to **claim 21**, Scheidig '565 discloses wherein display-name information set by said second setting means indicates which name to use from among the names

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set by said first setting means (Fig. 2b. col. 5, lines 22-35, user inputs setting data for different printer languages).

Referring to **claim 23**, Nguyen '941 discloses wherein the resource is a font resource used in printing, and/or a form resource for forming an image by being superimposed on print data at the time of printing, and/or a color-profile resource that expresses color space of an input/output device, and/or a look-up-table resource, which is a conversion table for color correction in color processing, and/or a dither-pattern resource, which is pattern data for deciding expression of color in color processing (col. 8, lines 64-65, font and raster modules).

Referring to **claim 27**, see the rejection of claim 20 above.

17. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen '941, Haines '030 and Scheidig '565 as applied to claim 20 above, and further in view of Forstall '869.

Referring to **claim 22**, Scheidig '565 discloses display-name information set by said second setting means but does not disclose expressly wherein the information indicates that the resource is not to be displayed.

Forstall '869 discloses information indicates that a resource is not to be displayed (col. 5, lines 33-57, hide extension bit associated with a file name).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to not display a resource. The motivation for doing so would have been to give the user a certain degree of control over the visibility of the user interface. Therefore, it



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would have been obvious to combine Forstall '869 with Nguyen '941, Haines '030 and Scheidig '565 to obtain the invention as specified in claim 22.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K Huntsinger/  
Examiner, Art Unit 2625

Art Unit: 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625